Navy Case No. 82,918 PATENTS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of :

William M. Appleman, et al. : Group Art Unit: 1723

Serial No. 09/879,870 : Examiner: Krishnan S. Menon

Filed: June 13, 2001 : CONFIRMATION NO. 4961

For: ARRANGEMENT AND CONSTRUCTION :
OF AN ELEMENT BUNDLING MODULE :

APPEAL BRIEF

Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This brief relates to an appeal seeking review by the Board of Patent Appeals and Interferences of the Examiner's decision finally rejecting claims 2 and 3 as set forth in the Final Office action dated July 14, 2003.

(1) REAL PARTY IN INTEREST

The party of interest in the above entitled application is the United States of America as represented by the Secretary of the Navy as assignee of the entire interest in the subject invention of the above named inventor.

(2) RELATED APPEALS AND INTERFERENCES

This appeal is related to a previous appeal noted Feb. 25, 2003 in the present application. Following the filing of a previous Appeal Brief on March 3, 2003, prosecution of the application was reopened by an Office action dated April 30, 2003, preceding a response thereto by an

Amendment filed May 15, 2003 through which claims 2 and 3 now under appeal were subjected to final rejection in the current Final Office action.

(3) STATUS OF CLAIMS

Claims 2 and 3 now on appeal were the only claims remaining pending in the application prior to the current Final Office action. Claims 1 and 4-7 were cancelled.

(4) STATUS OF AMENDMENTS

Two amendments were proposed under 35 U.S.C. 116 after receipt of the current Final Office action, preceding the noting of this appeal. Applicants were notified that such proposed amendments were not entered.

(5) SUMMARY OF THE INVENTION

A concise explanation of the subject invention covered by claims 2 and 3 on appeal, is as follows:

As described on pages 3-6 in the specification and illustrated in FIGS. 1-5 of the drawing, a housing (12) of a module (10) is internally provided with seal rings (22) to enclose a sealed chamber (25) within which elongated processing elements (20) are positioned and held bundled within the sealed chamber (25) by anchor holding discs (24). Contaminate-laden fluid flowing through the housing (12) is filtered by lateral flow through the processing elements (20) which are maintained in spaced relation to each other by spacers (28) so as to accommodate lateral withdrawal of a cleansed portion of the fluid for discharge from the housing (12) through an outlet drain (18) on the housing (12).

(6) ISSUES

Presented for review in this appeal are three final rejections under 35 U.S.C. 112, second paragraph, 35 U.S.C. 102(e) and 35 U.S.C. 103(a). The disclosures in U.S. Patent No. 6,284,451 to Funatsu et al and in U.S. Patent No. 5,916,440 to Garcera et al. are relied on as the only basis set forth for the final rejections under 35 U.S.C. 102/103. Five issues are involved in the latter referred to final rejections of claims 2 and 3, as follows:

(A) Are the claims indefinite as incomplete?

(B) Are the claims anticipated by the disclosure in the Funatsu et al. patent?

(C) Are the claims obvious over the Funatsu et al. patent?

(D) Are the claims anticipated by the disclosure in the Garcera et al. patent?

(E) Are the claims obvious over the Garcera et al. patent?

(7) GROUPING OF CLAIMS

Claims 2 and 3 form one group of claims related to an arrangement and construction of a fluid processing module, subject to all of the foregoing referred to final rejections.

(8) ARGUMENTS

(A) According to the final rejection of claims 2 and 3 under 35 U.S.C. 112, second paragraph as stated on page 2 of the current Final Office action, such claims are incomplete based on an interpretation of certain quoted claim recitation phrases, allegedly covering "circulation" of the contaminated-laden fluid within the sealed chamber so as to preclude lateral withdrawal and discharge of filtrate from the sealed chamber. However there is nothing in the claims which refers to "circulation" within the sealed chamber so as to preclude certain other recitations in claim 2 supported by the disclosure in the present application, relating to "withdrawal of the filtered fluid--and drain means on the housing for discharging--from the sealed chamber in

response to filtration by the elongated processing elements". The Examiner's latter referred to misinterpretation of claim 2 contrary to all of the claim recitations and the disclosure in the present application clearly does not justify the stated basis for the current final rejection under 35 U.S.C. 112 which is therefore in error.

Furthermore in an attempt to avoid the foregoing referred to improper basis for final rejection of claims 2 and 3 under 35 U.S.C. 112, applicants had proposed amendments to claim 2 under 35 U.S.C. 116 in an effort to avoid its misinterpretation. However such proposed amendments were denied entry.

(B) In regard to the final rejection of claims 2 and 3 under 35 U.S.C. 102(e) over the Funatsu et al. patent, the Final Office action on page 3, paragraph 1 conjectures that such prior art reference discloses a: "drain for discharge of clean fluid (6 fig. 1)". Presumably, the Examiner is referring the recitation in claim 2 of: "drain means--for discharging--cleansed portion of the contaminate-laden fluid from the sealed chamber in response to filtration". However according to column 5, lines 59-67 in the Funatsu et al. patent, part (6) is a housing inlet for cells 10 as shown in FIG. 1, rather than a discharge drain as referred to by the Examiner. Thus column 5, lines 59-67 in the Funatsu et al. patent states: "cells 10--fed from--cell inlet 6 formed in the housing 1--in the space 5". Therefore, the latter quoted portion of the disclosure in the Funatsu et al. patent clearly contradicts the Examiner's conjecture that the part 6 as disclosed in the Funatsu et al. patent is a "drain for discharge of clean fluid", in order to support the final rejection under 35 U.S.C. 102 over the Funatsu et al. patent. Such final rejection is therefore in error on one account.

Claim 2 is furthermore limited by another recitation to: "--sealed chamber through which the filtered fluid is laterally withdrawn--". No lateral withdrawal of filtered fluid is referred to or

disclosed in the Funatsu et al. patent, as called for in the latter quoted recitation of claim 2. Therefore, the final rejection of claims 2 and 3 over the Funatsu et al. patent under 35 U.S.C. 102(e) is in error on another account.

(C) As to the alternative final rejection of claims 2 and 3 over the Funatsu et al. patent under 35 U.S.C. 103(a), the only basis for such final rejection is grounded on the statement: "Claims 2 and 3 are--in the least, obvious over the reference as best understood under--35 U.S.C. 112". In view of the lack of any identification of what is considered obvious, a failure to cite or refer to some secondary prior art reference and the erroneous nature of the referred to final rejection under 35 U.S.C. 112 as hereinbefore pointed out, the alternative final rejection under 35 U.S.C. 103(a) is clearly in error.

(D) According to the final rejection of claims 2 and 3 under 35 U.S.C. 102(b) over the Garcera et al. patent, as set forth on pages 3 and 4, paragraph 2 of the Final Office action, the disclosure in the Garcera et al. patent is conjectured as featuring: "elongated process elements (1-fig. 1), sealed chamber (inside 1-fig. 1, seal 25), fluid--conducted through the elements (arrow 3-fig. 1)--drain means (4-fig. 1) for removing cleansed fluid--". However as previously pointed out of record by applicants and never contested by the Examiner, the elongated process elements 1 as disclosed in the Garcera et al. patent do <u>not</u> filter fluid that is laterally withdrawn and discharged by drainage from the housing as called for by recitation in claim 2. Accordingly, the final rejection over the Garcera et al. patent under 35 U.S.C. 102(b) as set forth in the Final Office action is also clearly in error.

(E) As to the alternative final rejection of claims 2 and 3 over the Garcera et al. patent under 35 U.S.C. 103(a), the only basis for such final rejection is grounded on the statement: "Claims 2 and 3 are--in the least, obvious over the reference as best understood under--35 U.S.C.

112". In view of the lack of any identification of what is considered obvious, the failure to cite or refer to some secondary prior art reference and the erroneous nature of the referred to final rejection under 35 U.S.C. 112 as hereinbefore pointed out, the alternative final rejection under 35 U.S.C. 103(a) is clearly in error.

In view of the reasons hereinbefore pointed out, involving quotations of recitations in claims 2 and 3 under appeal and references to actual portions of the disclosures in the Funatsu et al. and Garcera et al. patents, the final rejections as stated in the Final Office action are clearly in error and should therefore be reversed.

The Commissioner is hereby authorized to charge the Appeal Brief fee of $330.00 to Deposit Account No. 50-0958 or credit any overpayment.

Respectfully submitted,

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